

REMARKS

Applicants have carefully considered the January 2, 2009 final Office Action and the April 20, 2009 Advisory Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-9 are pending in this application. Claim 8 has been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

In response to the Office Action dated January 2, 2009, claims 1 and 9 have been amended. No new matter has been entered. Support for the amendments is found at Table 3, sample No. 12; and [0024] of the present application as published. Entry of the present response is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-7 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Izumida et al. (U.S. Pat. App. Pub. No. 2004/0099354, hereinafter “Izumida”). Applicants respectfully traverse.

The Examiner asserts that the highest reduction rate in area of 70% or more as disclosed by Izumida is the same as the lowest reduction rate in area of 70% as defined by the present application (Claim 9) and that one having ordinary skill in the art would achieve the same textures and properties as those of the present invention based on the steel wire of Izumida.

However, the steel wire of Izumida is produced by a process in which a reduction in area is completely different from that of the present claimed subject matter. Specifically, while the claimed steel wire is produced with the reduction in area of 85% or more (paragraph [0024] of the present application as published), the steel wire of Izumida is produced with the reduction in

area of 70% or less, desirably from 55% to 65 % (paragraph [0029] of Izumida). Also, test pieces in the embodiments of Izumida are obtained at the reduction in area of about 60%.

Due to the differences in the reduction in area, the claimed steel wire and the steel wire of Izumida are totally different in their respective textures. The claimed steel wire has a texture satisfying both  $I(200)/I(111) > 2.1$  and  $I(220)/I(111) > 3.4$ . On the other hand, setting the reduction in area at 70% would result in a texture merely satisfying  $I(200)/I(111) \leq 2.1$  and  $I(220)/I(111) \leq 3.4$  (see paragraphs [0024] and [0064] and Table 3 of the present application as published). For this reason, it should be evident that the steel wire of Izumida cannot obtain a texture satisfying both  $I(200)/I(111) > 2.1$  and  $I(220)/I(111) > 3.4$ , as presently recited in claim 1, since Izumida specifies the reduction in area of at most 70%.

Moreover, Izumida does not teach or remotely suggest setting the reduction in area at over 70%, particularly at 85% or more. On the contrary, Izumida mentions that it is undesirable to set the reduction in area at 70% or more because it degrades a high-temperature sag resistance (paragraph [00291] of Izumida). This teaching away a reduction area greater than 70% constitutes evidence of nonobviousness. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988), *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986), *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

From the teachings of Izumida, it is not easily conceivable even for one having ordinary skill in the art to provide the reduction in area of over 70%, much less 85% or more. Applicants submit that the only motivation for the claimed reduction in area is Applicants' own disclosure. Applicants' disclosure, however, is forbidden territory for the Examiner to obtain the requisite

motivation for modifying the applied prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

Accordingly, it is hardly possible to obtain the steel wire of the present invention satisfying both  $I(200)/I(111) > 2.1$  and  $I(220)/I(111) > 3.4$  with reference to Izumida. Based on the above, it should be evident that the present application discloses a totally different steel wire with a completely different texture as compared to the steel wire of Izumida.

The steel wire of Izumida is produced by a completely different production method and it does not have a texture satisfying the specified orientation of the present claimed subject matter. Each and every limitation must be disclosed or suggested by the cited prior art references in order to establish a *prima facie* case of obviousness (*see*, M.P.E.P. § 2143.03) and for at least the foregoing reasons the Examiner's applied reference fails to do so, it is respectfully submitted that the rejection is not legally viable for at least this reason and should be withdrawn for at least the foregoing reasons. Further, if any independent claim is non-obvious under 35 U.S.C. § 103(a), then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

#### Double Patenting Rejection

Claims 1-7 and 9 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 6 of Izumida. As acknowledged by the Examiner, U.S. Pat. App. Pub. No. 2004/0099354 issued as U.S. Pat. No. 7,404,865. Applicants traverse the rejection.

In response, Applicants note that a double patenting rejection of the obviousness-type is nearly analogous to the nonobviousness requirement of 35 U.S.C. § 103. See *In re Braithwaite*,

379 F.2d 594, 154 U.S.P.Q. 29 (CCPA 1967). Moreover, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. See *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985). The factual inquiries outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103, should be employed when making an obvious-type double patenting analysis. Therefore, Applicants respectfully traverse the obvious-type double patenting rejection for substantially the same reasons set forth above in response to the 35 U.S.C. § 103(a) rejection.

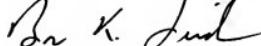
Moreover, the steel wire of Izumida has been obtained with reduction in area at 60% and does not have a texture satisfying both  $I(200)/I(111) > 2.1$  and  $I(220)/I(111) > 3.4$ . Since the texture of the steel wire of Izumida does not satisfy both  $I(200)/I(111) > 2.1$  and  $I(220)/I(111) > 3.4$ , the steel wire does not have fatigue limit as high as that of the steel wire of the present application. Furthermore, as already discussed, Izumida has a description that teaches away from controlling the reduction in area at 70% or more in the first place, thus, it has not been obvious, even based on Izumida, to set the reduction in area at 70% or more.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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